

REMARKS

Claims 1-11, 13-15 and 18-20 are pending and stand rejected. Reconsideration of the claim rejections is requested.

Claim Objections

Claim 1 has been amended to correct the informality cited on page 3 of the Office Action.

Claim Rejections 35 U.S.C. 112

Claims 1, 5, 10 and 13 are rejected for supposedly failing to comply with the written description requirement. The Examiner contends that the specification does not support the claimed features *wherein the first and second members are adapted to slide relative to each other along the first and second contact surfaces in response to a contact force while maintaining contact between the first and second contact surfaces to control the gap width*, as recited in claims 1, 5, 10 and 13. The rejection is traversed.

With regard to the legal issues regarding the written description requirement, the Examiner should note the following. In assessing whether a specification satisfies the "written description" requirement under 35 U.S.C. 112, first paragraph, with respect to the claimed invention(s), the fundamental factual inquiry is whether the patent specification describes the claimed invention with *reasonable* clarity such that one of ordinary skill in the art can reasonably conclude that the inventor(s) had possession of the claimed invention as of the filing date of the specification. See *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed Cir. 1991). Compliance with the written description requirement does not compel use of any particular form of description, so long as the description clearly allows one of ordinary skill in the art to recognize that the applicant invented what is defined by the patent claims. See *In Re Alton*, 76

F.3d 1168, 1172 (Fed. Cir. 1996). Indeed, it is well established that the subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. See *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000). “If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description is met.” *In re Alton*, 76 F.3d at 1175 (see also *Vas-Cath*, 935 F.2d at 1563).

The Examiner recognizes at the very least that the teachings on page 36, line 19 through page 37 line 2 are related to the claimed subject matter at issue. However, the Examiner find that the teachings that “even if a load is applied in a planar direction, the contact surfaces of the spacers 19a and 19b are rubbed by each other” do not describe “first and second members adapted to slide relative to each other along the first and second contact surfaces in response to a contact force” as claimed. The Examiner’s finding are untenable.

It is categorically clear that the cited passages in Applicants’ specification on pages 36-37 coupled with the illustrative structural embodiment of FIG. 11 provide clear support under the written description requirement for the recited claim features. FIG. 11 of Applicants specification coupled with the teachings on pages 36-37 describe an exemplary embodiment where each of the spacers are formed having a first member (19a) fixedly formed on the first substrate (13) and having a first contact surface, and a second member (19b) fixedly formed on the second substrate (14) and having a second contact surface in contact with the first contact surface of the first member (19a). With this structural framework, the first and second members (19a, 19b) are adapted to slide relative to each other along the first and second contact surfaces in

response to a contact force while maintaining contact between the first and second contact surfaces to control the gap width. The Examiner should further note the teachings on page 9 of Applicants' specification where the spacers are designed for "surface contact" as opposed to "point-contact".

In other words, the description on pages 36 and 37 essentially describe an exemplary embodiment as in FIG. 11 where each of the respective spacer members (19a) and (19b) are fixedly attached to the respective substrates (13) and (14) where in response to planar contact forces, the contacting surfaces of (19a) and (19b) will be "rubbed against each other" so prevent stresses at the points where the spacer members (19a, 19b) are fixedly attached to the substrates. The description of "the contact surfaces being rubbed against each other in response to a load in the planar direction" supports the claim language of the first members sliding relative to each other along the first and second contact surfaces (i.e., rubbing).

Irrespective of whether or not the subject matter of claims 1, 5, 10 and 13 is explicitly described *in haec verba* in the specification, in order to support this 112 rejection, it is incumbent on the Examiner to explain why one of ordinary skill in the art would not reasonably conclude that the inventor(s) had possession of the claimed inventions (1, 5, 10 and 13) as of the filing date of the specification given the above-cited disclosure. Without such a showing, the 112 rejections should be withdrawn.

Claim Rejections 35 U.S.C. 103

A. Claims 1, 2, 5-12, 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,852,487 to Fujimori et al. in view of U.S. Patent No.

5,499,128 A to Hasegawa et al.

B. Claims 13-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. US 2001/0051398 to Hirakata in view of Hasegawa.

C Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,852,487 to Fujimori in view of Hasegawa and further in view of Hatano (US. 6,331,881)

D. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujimori in view of Hasegawa and Hatano and further in view of Hirakata.

A. **With regard to the above rejection A**, it is respectfully submitted that at the very least, the combination of Fujimori and Hasegawa is legally deficient to establish a *prima facie* case of obviousness against independent Claims 1, 5 or 10. For example, the combination of Fujimori and Hasegawa does not disclose or fairly suggest, for example, a spacer comprising a first member fixedly formed on the first substrate and having a first contact surface, and a second member fixedly formed on the second substrate and having a second contact surface in contact with the first contact surface of the first member, *wherein the first and second members are adapted to slide relative to each other along the first and second contact surfaces in response to a contact force while maintaining contact between the first and second contact surfaces to control the gap width*, as commonly recited in claims 1, 5 and 10.

On page 4 of the Office Action, the Examiner relies on Fujimori (Col. 8, lines 58-64) as teaching polymer projections (11) disposed between first and second substrates (1, 2) (see, FIGs. 1 and 2), which Examiner contends reads on the claimed gap controlling spacers for restricting

the width of the gap and spacer movement. In the previous response, Applicants noted that the Examiner's characterization of Fujimori in this regard is actually belied by the express teaching by Fujimori, i.e., Col. 7, lines 56-60, where it is disclosed that **"a plurality of spacers (not shown) are provided for controlling the space between the substrates"**

In the response to Arguments Section of the Office Action, the Examiner maintains that Fujimori teaches in Col. 12, lines 42-48 that the polymer projections (111) are used as means to prevent deformation of the second substrate 2. Even assuming, arguendo, that the Examiner's findings are correct, the Examiner acknowledges that polymer projections are not similar in structure to the claimed spacers. Instead, the Examiner relies on Hasegawa as "inherently" teaching a spacer formed by two members that are brought into contact, *wherein the first and second members are adapted to slide relative to each other along the first and second contact surfaces in response to a contact force while maintaining contact between the first and second contact surfaces to control the gap width*. Irrespective of the Examiner's characterization of the polymer projections (11) as being spacers and Hasegawa's supposed inherent teachings, the Examiner's finding of obviousness is improper.

The Examiner asserted on pages 5-6 that it would have been obvious to modify Fujimori's polymer projections (11) with Hasegawa's spacers "in order to permit suppressing the light leakage around the spacer and hence achieving good picture image display" (Col. 24, lines s21-24). This finding is based on nothing more than impermissible hindsight reasoning in view of Applicants' teachings, in the Examiner has offered no reasonable motivation for combining Fujimori and Hasegawa by replacing the polymer projections (11) with the spacers (112d) in FIG. 13 of Hasegawa. The Examiner should note that However, it is axiomatic that if a

proposed modification would render a prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See, MPEP 2143.01, citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1964). Furthermore, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See, MPEP 2143.01, citing *In re Ratti*, 270 F.2d 810 (CCPA 1959).

Here, the Examiner's proposed modification simply replaces the polymer projections (11) with "spacers" having different structures and purposes, with utterly no sound reasoning to explain the basis or motivation for such modification. In fact, the Examiner's basis for the modification based on "permitting suppressing the light leakage around the spacer and hence achieving good picture image display" is irrelevant to the claimed inventions where the claimed spacer structures are designed for touch-sensing and to withstand the forces of touch-sensing while isolating the deformation to the center of the spacers and away from the contact surfaces with the substrates. In other words, there is no suggestion in Hasegawa that *wherein the first and second members are adapted to slide relative to each other along the first and second contact surfaces in response to a contact force while maintaining contact between the first and second contact surfaces to control the gap width.*

Thus, on a fundamental level the Examiner has offered no sound legal or factual reasoning to support the proposed modification of Fujimori's polymer projections (11) with Hasegawa's spacer structures. Accordingly, for at least the above reasons, the combination of Fujimori and Hasegawa is legally deficient to establish a *prima facie* case of obviousness against

claims 1, 5 or 10. Moreover, the combination of Fujimori and Hasegawa is legally deficient to establish a prima facie case of obviousness against claims 2, 6-11, 19 and 20 at least by virtue of their dependence from respective base claims 1 or 5.

With regard to the above rejection B, it is submitted that the combination of Hirikata and Hasegawa at the very least does not render claim 13 obvious. The Examiner has offered no reasonable basis or motivation for replacing the spacers of Hirikata's structure with the spacers in Hasegawa for the purpose of "suppressing light leakage around the spacer and hence, achieving a good picture image display", which is essentially irrelevant and off point with regard to the functional characteristics of the spacer structures as claimed in claim 13.

With regard to the above rejection C and D, Applicants submit that the obviousness rejections are improper for at least the same reasons give for base claim 1 from which claims 3 and 4 depend. Applicants request favorable reconsideration of the application as now presented. The Examiner is invited to contact the undersigned should he have any questions in this matter.

Respectfully submitted,



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